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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/827,428	04/20/2004	C. Alan Peet	87361.3660	2788

7590 08/23/2006

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EXAMINER
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LITHGOW, THOMAS M

ART UNIT	PAPER NUMBER
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1724

DATE MAILED: 08/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/827,428	<b>Applicant(s)</b> PEET ET AL.	
	<b>Examiner</b> Thomas M. Lithgow	<b>Art Unit</b> 1724	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 August 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) 23 and 24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 and 25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

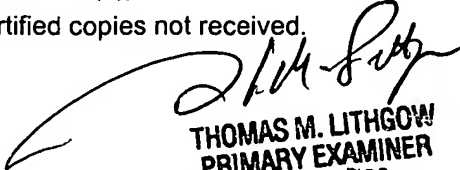
**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 August 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

  
**THOMAS M. LITHGOW**  
**PRIMARY EXAMINER**  
**GROUP 1700**

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>07 October 2005</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. Applicant's election with traverse of claims 1-22 and 25 in the reply filed on 03 August 2006 is acknowledged. The traversal is on the ground(s) that there was no showing of serious burden on the Office and that the Office has powerful search engines. This is not found persuasive because as set forth in paragraphs 4-6 of the Office action Restriction dated 05 July 2006, there is a serious burden on the Office. Further, the nature of the search tools available is restricted to text searching which has limited utility when searching mechanical features which are typically labeled any number of different names.

The requirement is still deemed proper and is therefore made FINAL.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-22 and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Kruse (US 4617122)-cited by applicant. The preamble of

claim 1 which recites “for use in engines or transmissions” is clearly a statement of intended use and will be treated as such. Kruse ‘122 discloses a pleated filter having a base 20 (as a first cover) with peripheral wave-like projections 30 and a frame 40 (as a second cover) with peripheral wave-like projections 50 which mate with the projections from the base and fix a filter media 60 there between. As the projections are three-dimensional any single projection can be considered “within the cover”. The covers are made of thermoplastic materials which are bonded to form the final filter [col. 5, lines 17+].

4. Claims 1-7, 10, 15-22 and 25 rejected under 35 U.S.C. 102(b) as being anticipated by JP 08-028376-cited by applicant. JP ‘376 discloses an air filter having a first cover 11 and a second cover 12 which cooperating wave-like regions that capture a pleated filter media 2.

5. Claims 1-7, 10, 15-22 and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Grauss (US 5885455)- cited by applicant. Grauss ‘455 discloses a filter unit having a first and second covers 2,3 with cooperating wave-like regions 9,9’ which capture and support the pleated filter media 6.

6. Claims 1-10, 15-22 and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 02-081609U. JP ‘609 discloses a filter unit 20

having an inlet and outlet covers 26 and 28 respectively with cooperating wave-like regions on both housing covers which capture a pleated filter media 30 there between.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 11-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 02-081609 U as applied to claim 1 above, and further in view of Gizowski (US 5853577). The use of opposed thermoplastic housing members in a transmission filter is taught by Gizowski '577. Such an arrangement allows for the bonding of the thermoplastic housing members to each other, by orbital bonding in this case, to secure the filter media to the housing members. The modification of JP '609U with such a feature would have been obvious to one of ordinary skill in the art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas M. Lithgow whose telephone number is 571-272-1162. The examiner can normally be reached on Mon. -Fri..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Duane Smith can be reached on 571-272-1166.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Thomas M. Lithgow  
Primary Examiner  
Art Unit 1724

TML